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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,049	02/02/2004	John N. Gross	JNG 2004-5	1525
23694	7590	06/20/2006	EXAMINER	
J. NICHOLAS GROSS, ATTORNEY			RUHL, DENNIS WILLIAM	
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SUITE 610			ART UNIT	PAPER NUMBER
BERKELEY, CA 94704				3629

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/771,049	GROSS, JOHN N.
	Examiner	Art Unit
	Dennis Ruhl	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 March 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-18 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-18 and 21-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

The amendment of 3/28/06 has been entered. Currently claims 2-18,21-34 are pending. Upon further consideration of the claimed subject matter and in view of newly found prior art, it has been determined that a prior art rejection is warranted and the indication of allowable subject matter is withdrawn. This office action is non-final.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7,8,9,12,13,23, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 7,8,9, it is not clear as to what the portion of the claim that recites the trigger event and what it is based on is actually claiming. What structure or steps does this language define? This portion of the claims does not appear to be any kind of method step. This portion also does not appear to be reciting any structure that is related to the system used in the method. One wishing to avoid infringement would not understand what the scope of these claims are because the language is indefinite. As an example, in claim 8, is the item recommendation system itself part of the claim and has an item recommendation actually been generated? It is not clear as to what this language adds to the claims and what it defines as far as steps go or structure goes.

For claim 13, if claim 2 recites that a notification is sent based on a re-ordering of the queue or based on a recommended new item to be added to the queue, and if claim 13 recites that the subscriber can elect to have no notification sent, what then is the

resulting method that is being claimed? Is a notification now being taken out of the scope of the claim? If one were to elect to not receive notifications relating to portion b) of claim 2, then what is the scope of the claim?

For claim 23, it is not clear as to what the scope of the claim is. It is not clear if the claim scope requires a 2<sup>nd</sup> notification because of the fact that it is recited that the 2<sup>nd</sup> notification is in response to a subscriber action; however, the claims recite no subscriber action of any kind occurring. If no subscriber action is occurring, there is no 2<sup>nd</sup> notification. Method claims are for recitations of actual acts being performed or executed and because there is no subscriber action occurring, it is not clear if there is a 2<sup>nd</sup> notification in the scope of the claim.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-18,21-34, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al. (6584450) in view of Elston (6055505).

For claims 2,6,15,21,23 (as best understood), Hastings discloses a method for renting items from a content provider where the customer sets up a rental queue. A set of queue replenishment rules are employed to determine if the ordering of the titles in the queue should be changed. When a DVD is returned (a trigger event) the system checks the queue rules (Max Out option and/or Max Turns) to determine if the ordering

of the queue should be changed. When a new DVD is shipped, the ordering of the queue is changed because that title is taken out of the queue and is then in a checked out status. Not disclosed is a set of notification rules that will electronically notify the subscriber when the ordering of the queue has been changed based on the monitoring of the queue. Elston discloses an automatic customer notification system that notifies customers of a business or other entity of the fact that an event has occurred that involves that business or entity. Elston discloses that when an event of interest to the customer occurs, the system will notify the customer by phone, fax, or even email. See column 4, lines 1-5. Elston discloses in column 5, lines 3-12 that the system and method of customer notification can be used for accounts at financial institutions, for medical patients and test results, for college students and notification of the posting of grades. The invention is not limited to just the notification of financial events but can be used in other environments where notification of an event would be desirable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hastings with a notification system as disclosed by Elston so that when there is activity happening in the rental queue of Hastings that is of interest to the customer, the customer can be notified of the activity. An example would be the sending out of a notification when a new DVD title is being shipped to the subscriber. With respect to the language reciting that the notification rules include a user configurable option to automatically trigger or not trigger a modification to the subscriber rental queue, this has been interpreted to be non-functional descriptive material that does not serve as a limitation. This is because the user configurable option is not functionally related to the

rest of the claimed method and this portion of the claim is not reciting any kind of method step. An option is essentially a choice, which is not a real world thing but is an intangible, so as far as structure goes, this portion of the claim is not reciting any structure to the system that is used in the method. The examiner does not see how the recitation of there being a user configurable option is functionally related to the rest of the claim. In the claim, the fact that a notification is sent is not necessarily related to the user configurable option, it may be that there is another rule in the notification rules that results in the notification being sent out; therefore, the user configurable option is not functionally related to the rest of the claim. The language reciting "defining a set of notification rules" can include the act of writing the rules down on paper, so when the claim later recites more about what the rules include, this is taken to be non-functional descriptive material that does not serve to distinguish over the prior art.

For claim 4, in Hastings the rental queue is automatically modified when a movie is returned and this does not happen instantaneously, it happens after a predetermined time delay, which is due to the speed at which changes can occur by using technology. The modification will happen as fast as the technology is capable of making the modification.

For claims 5,17,18,21,22,24, reciting that the notification contains directions for the subscriber to follow and/or contains a status of the queue and/or identifies a particular movie, etc., is considered to be non-functional descriptive material. The directions or status are not used in any manner in the method and can be just text contained in the notification itself, which is non-functional descriptive material.

For claims 7,30-32,34, Hastings discloses a method for renting items from a content provider where the customer sets up a rental queue. A set of queue replenishment rules are employed to determine if the ordering of the titles in the queue should be changed. When a DVD is returned (a trigger event) the system checks the queue rules (Max Out option and/or Max Turns) to determine if the ordering of the queue should be changed. When a new DVD is shipped, the ordering of the queue is changed because that title is taken out of the queue and is then in a checked out status. Not disclosed is a set of notification rules that will electronically notify the subscriber when the ordering of the queue has been changed based on the monitoring of the queue. Elston discloses an automatic customer notification system that notifies customers of a business or other entity of the fact that an event has occurred that involves that business or entity. Elston discloses that when an event of interest to the customer occurs, the system will notify the customer by phone, fax, or even email. See column 4, lines 1-5. Elston discloses in column 5, lines 3-12 that the system and method of customer notification can be used for accounts at financial institutions, for medical patients and test results, for college students and notification of the posting of grades. The invention is not limited to just the notification of financial events but can be used in other environments where notification of an event would be desirable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hastings with a notification system as disclosed by Elston so that when there is activity happening in the rental queue of Hastings that is of interest to the customer, the customer can be notified of the activity. An example would be the sending out of a

notification when a new DVD title is being shipped to the subscriber. With respect to the language reciting that the queue replenishment rules include a trigger event that is based on the quantity of items remaining in the queue, this has been interpreted in two manners. 1) The first interpretation is that this language is interpreted to be non-functional descriptive material that does not serve as a limitation. This is because the trigger option and the number of items in the queue is not functionally related to the rest of the claimed method and this portion of the claim is not reciting any kind of method step. The examiner does not see how the recitation of the trigger event being based on the quantity of items remaining in the queue is functionally related to the rest of the claim. In the claim, the fact that a notification is sent is not necessarily related to the trigger event or the number of items remaining in the queue, it may be that there is another rule in the notification rules or the queue replenishment rules that results in the notification being sent out; therefore, the trigger event of the queue replenishment rules is not functionally related to the rest of the claim. Hastings discloses a trigger event so this satisfies what is claimed because the kind of trigger event is not given patentable weight. 2) The second interpretation is giving much more weight to the limitation of the trigger event being based on the quantity of items remaining in the queue. With respect to this limitation, the examiner takes official notice that it is well known to notify customers of the fact that an account is getting low and that the account balance needs to be modified. An example would be a financial account where customers can be notified of a low account balance so that the customer can take steps to ensure that the balance is kept at a satisfactory level. Children going to elementary school use meal

cards (pre-paid cards) to pay for meals. When the account balance is getting low the school sends out a notification to the parents to inform them that the meal card balance is getting low. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the customer with a notification when it is determined that their queue is empty and that a modification to the queue should occur if they want to receive more DVD items. The fact there are no movies in a subscriber's queue is something that the subscriber would like to know about (one of ordinary skill in the art would recognize this) so that they can modify the queue and receive another movie.

For claim 3, reciting that the notification specifies that the queue will be automatically modified is considered to be non-functional descriptive material. This is reciting the content of the notification itself, which can be just the text of an email, which is non-functional descriptive material.

For claims 8,9,18,25,27,29, Hastings discloses a method for renting items from a content provider where the customer sets up a rental queue. A set of queue replenishment rules are employed to determine if the ordering of the titles in the queue should be changed or if an additionally playable media title should be added to the queue. When a DVD is returned (a trigger event) the system checks the queue rules (Max Out option and/or Max Turns) to determine if the ordering of the queue should be changed. When a new DVD is shipped, the ordering of the queue is changed because that title is taken out of the queue and is then in a checked out status. With respect to the addition of an additionally playable media item to the subscriber rental queue, Hastings discloses that the subscriber can choose preferences/attributes about what

movies they would like to see and the content provider will automatically select those movies for the subscriber. See column 8, lines 43-60. This is considered to be the claimed item recommendation system because this aspect of the system of Hastings recommends movies based on the preferences that the subscriber has provided (i.e. horror movies released in 1999 or any adventure movies with Harrison Ford as an actor). Not disclosed is a set of notification rules that, based on the monitoring of the queue, will electronically notify the subscriber when the ordering of the queue has been changed or when an additionally playable media item is being added to the queue.

Elston discloses an automatic customer notification system that notifies customers of a business or other entity of the fact that an event has occurred that involves that business or entity. Elston discloses that when an event of interest to the customer occurs, the system will notify the customer by phone, fax, or even email. See column 4, lines 1-5. Elston discloses in column 5, lines 3-12 that the system and method of customer notification can be used for accounts at financial institutions, for medical patients and test results, for college students and notification of the posting of grades. The invention is not limited to just the notification of financial events but can be used in other environments where notification of an event would be desirable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hastings with a notification system as disclosed by Elston so that when there is activity happening in the rental queue of Hastings that is of interest to the customer (renumbering of the ordering or the addition of a new movie from the recommender system), the customer can be notified of the activity. Examples would be the sending

out of a notification when a new DVD title is being shipped to the subscriber (queue re-ordering) or when a new movie is being added (i.e. a new adventure movie with Harrison Ford was just released).

For claims 9,28, in addition to that immediately above, the prior art does not disclose that the newly added recommended playable media is designated as the next one to be delivered to the customer. Hastings discloses that one of the preferences that the subscriber can set is the order in which movies are to be received, see column 8, lines 43-65. This includes the situation where the subscriber decides that any movies recommended to them by the system of Hastings should be the next to be sent out. Because Hastings allows subscribers to have movies recommended by a recommender system and because Hastings allows a subscriber to set forth the priority for the ordering of the movies to be sent, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hastings with the ability to designate any recommended movies as the next to be delivered to the subscriber.

For claims 10,11, Hastings discloses that the subscriber can choose preferences/attributes about what movies they would like to see and the content provider will automatically select those movies for the subscriber. See column 8, lines 43-60. This is considered to be the claimed item recommendation system because this aspect of the system of Hastings recommends movies based on the preferences that the subscriber has provided (i.e. horror movies released in 1999 or any adventure movies with Harrison Ford as an actor). The preferences are provided via an item rating survey that is used to match the preferences to recommended movies.

For claims 12,24, not disclosed is the receiving of feedback. The examiner takes official notice that obtaining feedback on the service or products that a business provides is old and well known in the art. Many businesses survey their customers to obtain important information on their business so that they can improve in areas that the survey indicates as needing improvement. It would have been obvious to one of ordinary skill in the art to solicit and receive feedback on the movie recommendation system so that you can improve it and make it more accurate to what the customer actually likes. Customer feedback is nothing new.

For claim 13, not disclosed is that the subscriber can elect to have no notification sent. Elston discloses that the customer is presented with options concerning the kind of events that would result in a notification being sent out. Elston teaches that within one business and the activities that occur with the business, the customer can elect to have notifications sent only when certain events happen. Based on this fact and when one considers its use in the system and method of Hastings, it would have been obvious to one of ordinary skill in the art to allow the subscriber to elect what kinds of events related to the rental queue will trigger a notification being sent so that not all events trigger a notification.

For claims 14,16,33, not disclosed is that the movies are distributed by a satellite transmission to a receiver or by the Internet. Hastings discloses that the movies can be delivered to the customer in just about any manner and discloses in column 4, lines 22-34 that the delivery channel "may be implemented by any mechanism that provides for the transfer of items" from the provider to the subscriber "and the invention is not limited

to any particular type of delivery channel". The examiner takes official notice that it is old and well known in the art to deliver movies by satellite to a receiver and for movies to be delivered over the Internet. The examiner notes that Direct TV has been around for many years and has delivered movies to customers by satellite (pay per view channels). Movies have been distributed via the Internet for years, one of ordinary skill in the art would be very informed of this fact. Based on the teachings of Hastings and the knowledge of one of ordinary skill in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system and method of Hastings for the delivery of movies by satellite because this is just another delivery channel well known to one of ordinary skill in the art.

For claim 26, in Hastings, if the subscriber wants to remove the movie that was added by the recommender system, they can do so. Hastings discloses the claimed ability to remove movies from the subscriber queue.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bos et al. (20020058496), Teicher (20040242208), and Sullivan et al. (20030078983) are representative of and contain examples of low account notifications to customers of the accounts.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL  
PRIMARY EXAMINER